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09/819,965	03/28/2001	Takao Yoshimine	275745US6	4221
22850	7590	10/28/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
CHAMPAGNE, DONALD				
ART UNIT		PAPER NUMBER		
3688				
NOTIFICATION DATE		DELIVERY MODE		
10/28/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

# Office Action Summary

**Application No.**

09/819,965

**Applicant(s)**

YOSHIMINE ET AL.

**Examiner**

Donald L. Champagne

**Art Unit**

3688

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 August 2009.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 37-40, 48-51, 59-62, and 97-106 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 37-40, 48-51, 59-62 and 97-106 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 28 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4 August 2009 has been entered.

### ***Claim Interpretation***

2. The plain meaning of "**predetermined** information" (e.g., at claim 37, line 4) is information determined "pre" to some time or event. The instant application never defines any such time or event, so the "pre" is meaningless. "Predetermined information" is simply interpreted as "information" (since information is inherently "determined").

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 37-40, 48-51, 59-62, and 97-106 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In each independent claim 37, 48, 59 and 97, "user location(s)" (e.g., at line 6 of claim 48) is new matter (introduced with the amendment filed 17 April 2008). See para. 7 below for guidance on overcoming this rejection.
5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 37-40, 48-51, 59-62, and 97-106 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At the last two lines of each independent claim 37, 48, 59 and 97, the following phrase is indefinite:

"by providing the personal computer with a graphical user interface after receiving the predetermined information."

A graphical user interface is either installed on a computer or it is not. It is not clear how a GUI can be provided "after receiving the predetermined information." This rejection can be overcome by amending to make clear that it is "changing the information defining genre" that is accomplished "after receiving the predetermined information".

7. Claims 37-40, 48-51, 59-62, and 97-106 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In each independent claim 37, 48, 59 and 97, "user location(s)" (e.g., at line 6 of claim 48) is indefinite because the claim is to the recipient of information, while the spec. uses "user" only to mean the creator and supplier of information. This rejection can be overcome by replacing "user location(s)" with "client location(s)".

***Claim Rejections - 35 USC § 102 and 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 37-39, 48-50, 59-61 and 97-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griebenow et al. (US005850520A, hereafter Griebenow) in view of Microsoft Windows (Wikipedia article).
10. Griebenow teaches (independent claims 37, 48, 59 and 97) an apparatus, method and computer readable storage medium, the method (claim 48) comprising:

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receiving from a personal computer (*publisher's computer 14*, col. 3 lines 24-26) via internet (col. 2 lines 56-65), user content data (*an electronic publication*, col. 43-45) transmitted therefrom, and predetermined information (a *publication* ordered previously, col. 6 lines 63-65) transmitted separately from the user content data;

receiving a request (*consumer order*, col. 3 line 65 to col. 4 line 5) from one or more user locations (*consumer's computer 12*) for selected content data, the request including information specifying content data to be transmitted (*the publication that the consumer desires to order*, col. 6 lines 55-58);

referring to on-demand schedule control information (*an order event*, col. 4 lines 20-28) based on the information specifying content data to be transmitted and retrieving the selected content data (col. 4 lines 32-34);

transmitting, via a network, the selected content data to one or more user locations (col. 4 lines 34-45) along with a commercial (*customized advertising*) selected in accordance with the on-demand schedule control information (col. 7 lines 21-49 and *advertising timing*, col. 10 lines 34-41); and

the consumer ordering a publication dealing with a specific subject (col. 7 lines 33-36), other than *bicycling*, which reads changing the information defining genre of the user content data (e.g., *bicycling*) transmitted by the personal computer to a different genre after receiving the predetermined information (col. 6 lines 63-65 and col. 7 lines 23-49).

11. Griebenow does not teach, providing the personal computer with a graphical user interface in order to change the information defining genre of the user content data transmitted by the personal computer to a different genre after receiving the predetermined information. Microsoft Windows teaches providing any personal computer with a graphical user interface. Because Microsoft Windows teaches that GUI's are popular (a growing interest" in 1985), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Microsoft Windows to those of Griebenow.
12. In addition, under *KSR v. Teleflex* (82 USPQ 2d 1385), the combination would be obvious because prior art elements are being combined according to known methods to yield predictable results. Griebenow teaches every feature of the claims except the popular GUI. Microsoft Windows adds the popular GUI.

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13. In addition, none of the references teach literally providing the personal computer with a graphical user interface after receiving the predetermined information. This would have been obvious to one of ordinary skill in the art, at the time of the invention, if the information request and download process required a GUI not yet installed on the recipient user location machine.

14. The following claim language is non-functional descriptive material (printed matter) and was not given patentable weight (MPEP § 2106.01 and 706.03(a)A):

“including at least category information defining a genre of the content data” (claim 48, lines 4-5).

Printed matter is not functional because it does not alter how the process steps are to be performed to achieve the utility of the invention.

15. Griebenow also teaches at the citations given above claims 99-102.

16. Griebenow also teaches claims 38, 39, 49, 50, 60 and 61 (col. 10 lines 21-25); claim 98 (at the citations given above and col. 6 lines 43-58, where *web page* reads on “URL”); and claims 103-106 (col. 10 lines 58-65).

17. Claims 40, 51 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griebenow in view of Microsoft Windows (Wikipedia article) and further in view of Logan et al. (US005721827A, hereafter “Logan”).

18. Neither Griebenow nor Microsoft Windows teaches calculating an amount of money to be earned by the user of the personal computer for self-distributing the content data. Logan teaches calculating an amount of money to be earned by the user of the personal computer for self-distributing the content data, inherently as revenue minus total costs, including sub-steps of:

determine revenue equal to service user charges, where said revenue/service user charges may vary with the amount of advertising accepted by the customers/*subscribers* (col. 9 lines 5-11),

retrieving data representing a number of times the content data was accessed by users (the *Plays field*, col. 19 line 63 to col. 20 line 1) of the application service provider,

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determining an amount of money (*Amount*, col. 20 lines 1-20) that corresponds to the number of times the content data was accessed by users of the application service provider, and

determining an adjustment to the service user charges by depending on the amount of advertising accepted by the customers/*subscribers*, by subtracting the amount of money that corresponds to the number of times the content data was accessed by users of the application service provider from the service user charges (in the formula at col. 20 line 13).

Under *KSR v. Teleflex* (82 USPQ 2d 1385), the combination of Logan with Griebenow and Microsoft Windows would be obvious because prior art elements are being combined according to known methods to yield predictable results. It is obvious that the service provider/"user of the personal computer" would need to earn an amount of money for self-distributing the content data, and Griebenow teaches this amount of money as the *consumer bill*, but provides no details as to how said bill could be determined. Logan provides these details.

19. Neither Griebenow nor Logan teaches that the "amount of money" is determined in part by adding a connection fee of an Internet serviced provider. It would be obvious to do so when the information serviced provider/"user of the personal computer" was also providing Internet service.

### ***Response to Arguments***

20. Applicant's arguments filed with an amendment on 4 August 2009 have been fully considered in the revised rejection.

### ***Possibility of Allowable Subject Matter***

19. Patentable weight would have to be given to the choice/change of genre if it were made functional, e.g., by clicking the genre setup button 85A (para. [0146] in the published application, US 20020046097A1). Indeed, the specification from figure 14 forward and the associated text is rich in functional detail that might distinguish the instant application over the prior art.
20. Applicant is cautioned that an allowance could not be considered until this or any other amendment was searched.

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***Conclusion***

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached on Monday to Wednesday and Friday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
22. The examiner's supervisor, Robert Weinhardt, can be reached on 571-272-6633. The fax phone number for all *formal* fax communications is 571-273-8300.
23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

21 October 2009

/Donald L. Champagne/  
Primary Examiner, Art Unit 3688